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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,696	12/20/2001	Missy L. Villapudua	020375-003100US	4166

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EXAMINER

WOO, RICHARD SUKYOON

ART UNIT PAPER NUMBER

3639

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,696

Applicant(s)

VILLAPUDUA, MISSY L.

Examiner

Richard Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-10 and 13-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

- 1) Applicant's amendments filed on March 29, 2005 have been entered.
- 2) Applicant's arguments filed on March 29, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that Walter does not disclose the claimed invention because the loyalty card is not part of the payment instrument and Walter only shows the loyalty card has a magnetic strip to contain the customer information, this is respectfully traversed by the examiner. The paragraph [0025] of Walter discloses that the customer information should be obtained from any user's card including the alleged loyalty card (see "Information from a user's card is thus obtained by the reader..." in paragraph [0025]).

In response to applicant's argument that Walter does not request the personal data and privacy preference before the payment instrument is issued, the examiner respectfully asks the applicant when was the last time the credit card issuer issues the credit card before obtaining even the name of the holder (personal data). This is an INHERENT feature for any payment instrument field to ask the user to provide the private personal data and privacy preference before issuing the payment instrument.

- 3) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

4) Claims 1-10 and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Walter (US 2002/0087472).

W.R.T. Claim 1:

Walter discloses a method for protecting consumer personal data, comprising:
receiving an application for a payment instrument (e.g. smart card or loyalty card in Fig. 3), wherein the application comprises personal data and a privacy preference of a consumer and wherein the application is requested before the payment instrument is issued (see paragraph [0045], see Fig. 4);

saving the application in a database (see Figs. 1 and 5) that is associated with an issuing financial institution who issued the payment instrument (see paragraph [0044] for the inherent financial institution, which is issuing the card);

storing at least some of the personal data and the privacy preference onto the payment instrument, wherein the payment instrument includes consumer account information necessary to tie a debit or credit payment transaction to a consumer account that is associated with the issuing financial institution (see paragraphs [0025], [0036]-[0038]); and

receiving a purchase request at a credit or debit processing system that is associated with a merchant financial institution, wherein the purchase request is in response to presentation of the payment instrument and the customer account

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information and at least some of the personal data and the privacy preference (see paragraphs [0012]-[0013], [0036]-[0038], [0040], [0044]); and

saving the privacy preference in a database associated with the merchant financial institution (28) (see Id.),

wherein the purchase request provides the consumer account information as well as the personal data and the privacy preference from the user of the payment instrument, without separate entry of the personal data and the privacy preference from an instrument other than the payment instrument (see Supra paragraphs and Response to Arguments).

W.R.T. Claims 2 and 4: Walter also discloses the method, wherein the payment instrument comprises a credit or debit card having a magnetic stripe, or a processor and memory (smart card) (see Supra paragraphs);

W.R.T. Claim 3: Walter further discloses the method, wherein the payment instrument includes a check, and wherein the privacy preference is printed onto the check (see Supra paragraph [0025]);

W.R.T. Claim 5: Walter also discloses the method including the step of reading the personal data and the preference at a merchant location when the consumer's payment instrument is accessed, and saving the data at the merchant storage location (see paragraphs [0012]-[0013], [0036]-[0038], [0040], [0044]);

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W.R.T. Claim 6: Walter also discloses the method including the step of mailing marketing material to the consumer only if permitted by the consumer's privacy preference (see paragraph [0003]);

W.R.T. Claims 7-8: Walter also discloses the method, wherein the privacy preference indicates that consumer receives marketing material only from affiliated merchants (see paragraphs [0003], [0006] by controlling the type of personal data that may be collected);

W.R.T. Claim 9: Walter also discloses the method, wherein the privacy preference indicates that consumer receives marketing material only from the affiliated bank (*Id.*); and

W.R.T. Claim 10: Walter also discloses the method, wherein the privacy preference indicates that the consumer opts out (see paragraph [0008]).

W.R.T. Claim 13:

Walter discloses a method for protecting consumer personal data, comprising:
providing the consumer with a payment instrument (smart card) having stored thereon a privacy preference, wherein the payment instrument further includes consumer account information necessary to tie or credit payment transaction to a consumer account (see paragraphs [0025], [0036]-[0038]);

reading the privacy preference from the payment instrument when making a purchase at a merchant location, wherein the consumer account information is read to provide payment to a merchant (see *Id.*),

wherein the purchase request provides the consumer account information as well as the personal data and the privacy preference from the user of the payment instrument, without separate entry of the personal data and the privacy preference from an instrument other than the payment instrument (see Supra paragraphs and Response to Arguments);

saving the application in a merchant database (see paragraphs [0012]-[0013], [0036]-[0038], [0040], [0044] and abstract); and

contacting the consumer in accordance with the privacy preference (see Supra Claims 6-9; the consumer controls what types of information that may be used).

W.R.T. Claims 14 and 16: Walter also discloses the method, wherein the payment instrument comprises a credit or debit card having a magnetic stripe, or a processor and memory (smart card) (see Supra paragraph [0025]); and

W.R.T. Claim 15: Walter further discloses the method, wherein the payment instrument includes a check, and wherein the privacy preference is printed onto the check (see Supra paragraph [0025]).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within


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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

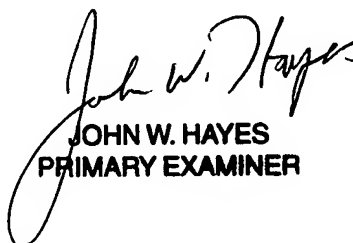
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 571-272-6813. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Woo
Art Unit 3639
July 10, 2005



JOHN W. HAYES
PRIMARY EXAMINER